

# Browne & Woods LLP

## MEMORANDUM

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### STATE BAR OF CALIFORNIA INTELLECTUAL PROPERTY SECTION TRADE SECRET COMMITTEE

#### *March 15, 2005 Meeting Minutes*

The Trade Secrets Committee held a telephonic meeting on March 18, 2005.

The following are the minutes of that meeting:

1. **Attendance.** The following Committee members attended the meeting: Ben Scheibe, Joanna Mendoza, Bec Edelsen, Randy Kay, Bart Smith, Scott Plamandon, John Yates, and Brian Walton.

2. **Update On Trade Secrets Treatise.** Randy updated Committee members on the progress of the trade secret treatise that was edited by and written by members of the Committee. It is anticipated that the treatise will be promoted again at the April 2005 In-House Counsel program in San Jose and published through the State Bar later this year.

3. **Upcoming programs.** The members discussed upcoming programs, which included:

- a. **April 2005** – Bec, Ben, Joanna, and Randy will be speaking on two different panels at the Intellectual Property Litigation Issues for In-House

Counsel program to be held on April 27 and 28, 200 in San Jose. Bec, Joanna, and Randy will speak on Trade Secrets and Competitive Position at 11:00 a.m. on April 27; Ben will participate in a panel discussing Trial Issues in IP Litigation Panel at 10:30 a.m. on April 28.

**b. February 10, 2005 lunch program rescheduled to May 19, 2005:** The lunch program developed by Bec and entitled "*Protecting Your Business From Departing Employees*" has been rescheduled for May 19, 2005, to be held at Alschuler Grossman Stein & Kahan.

**c. November 2005:** The Committee will be developing two programs for the IP Institute to be held November 4-5, 2005 at the Napa Valley Marriott Hotel and Spa:

- i. 11/4 8:30 a.m.: Trade Secret Year-in-Review program
- ii. 11/4 2:45 p.m.: Panel discussion on as-yet undetermined topics.

Ben is organizing Committee members who have ideas for topics and/or speakers should contact Ben.

**4. Speaking Opportunities/Writing Opportunities.** The Committee members discussed the need for the Committee to keep a flow of articles to *New Matter*. John Yates and Ben Scheibe have articles in progress. Members interested in writing an article (from 1500 to 6000 words) should e-mail Ben or the editors of *New Matter* (with a copy to Ben) with a proposed topic and target date so as to reserve the topic with *New Matter*. The articles need not be in depth, law review type articles, and can cover narrow topics that may be of interest to members of the IP Section. Members are

encouraged to take briefs or research memoranda from their practice and turn these into articles if the topics are of interest to the trade secret or IP community.

**5. Case Law Discussion.** John Yates briefed the Committee and conducted a discussion on the recent case of *Readylink Healthcare v. Cotton*. In addition, the members discussed some trial court cases of interest, including the Apple case involving Apple's suit against a web blogger who leaked details of an upcoming Apple product release.

**6. Plain English Trade Secret Jury Instruction Project.** As mentioned in prior minutes, a subcommittee has been established, consisting of Ben Scheibe, Carolyn Sieve, Randy Kay, Marshall Lerner, Bec Edelson, and Robert Freitas. Robert Freitas has volunteered to head the Committee and to act as a clearinghouse to collect instructions from Committee members. Although Robert has received a few instructions, he has asked for additional instructions from Committee members. All Committee members are encouraged to provide trade secret instructions they have found useful in the past to Robert Freitas: [RFreitas@Orrick.com](mailto:RFreitas@Orrick.com)

**7. New Project(s).**

- a. Website:** The "Frequently Asked Questions" page on our Committee's website is somewhat out of date. Committee members are asked to review the page with an eye towards updating the pages and making them more user friendly. Vice Chair David Morales is heading up this project. Although David has heard from one or two volunteers, additional volunteers would be helpful. Volunteers should e-mail David ([dmorales@lgpatlaw.com](mailto:dmorales@lgpatlaw.com)) and suggestions for website improvements can be e-mailed to David as well or submitted at the next meeting. Our current pages may be viewed at:

[http://www.calbar.ca.gov/state/calbar/calbar\\_sections\\_generic.jsp?sImagePath=Intellectual-Property-Section\\_with-right-menu.gif&sCategoryPath=/Home/Attorney%20Resources/Sections/Intellectual%20Property%20Law/Standing%20Committees/Trade%20Secrets&sAdsPath=sectionsads/IP\\_Cmte\\_Secrets\\_Home.html&sFileType=HTML&sRightMenuPath=sectionsrightmenu/IP\\_Cmte\\_Home-Page.html&sCatHtmlPath=html/IP\\_Cmte\\_Secrets\\_Home.html](http://www.calbar.ca.gov/state/calbar/calbar_sections_generic.jsp?sImagePath=Intellectual-Property-Section_with-right-menu.gif&sCategoryPath=/Home/Attorney%20Resources/Sections/Intellectual%20Property%20Law/Standing%20Committees/Trade%20Secrets&sAdsPath=sectionsads/IP_Cmte_Secrets_Home.html&sFileType=HTML&sRightMenuPath=sectionsrightmenu/IP_Cmte_Home-Page.html&sCatHtmlPath=html/IP_Cmte_Secrets_Home.html)

- b. **CLE By Phone:** The members further discussed the idea of the Committee hosting telephonic CLE programs on trade secret related topics. The programs would be one hour; participants would participate by phone and receive CLE credit through the State Bar. There seems to be sufficient interest among committee members and Committee members were asked to think about potential topics and speakers. David Shaub is working on a potential program.
- c. **Legislative Reform:** Interest was previously expressed in possibly proposing legislative reform on issues of interest to trade secret practitioners. One such issue is the possible abuse of the litigation process by asserting spurious claims of trade secrets in order to obtain access to a competitor's confidential information. Joanna Mendoza has circulated a draft identifying the issue and a possible remedy through the amendment of CCP § 2019(d). Jim Pooley has expressed interest in this project as well. An ad hoc sub-committee is looking at these issues and will report back to the Committee as a whole.

**8. Next Meeting.** The Trade Secret Committee will have its next telephonic meeting on May 10, 2005 at 3:00 p.m. Ben will circulate call-in information in advance of the meeting.